

Appln. No.: 09/732,530
Amdt. Dated January 11, 2006
Reply to Office Action dated November 18, 2005

Remarks/Arguments

Reconsideration of this Application is requested.

In the January 14, 2005, Patent Office Action the Examiner objected to the drawings. In applicants March 14, 2005, amendment applicant amended the specification and corrected Fig. 7 to overcome the Examiner's objection. The Examiner did not indicate in the March 14, 2005, Final Rejection whether or not the drawings have been approved. Will the Examiner please indicate whether or not the drawings are acceptable.

Claims 1 and 3 have been rejected by the Examiner under 35 USC §103(a) as being clearly anticipated by either Belson et al. (3,644,806) or Riley (3,917,048) or Kondo (4,971,466).

Belson discloses the following in column 1, lines 8-34:

"The vast amount of printed output generated by today's high-speed computers has created a demand for ever faster printer devices. Traditionally, these devices print a line and then advance the paper one or more lines and print another line. Ideally, consecutive lines should be identically spaced with characters, all of which are not simultaneously printed, in a straight line. To speed operation, each line must be printed and the paper transported between printed lines as rapidly as possible.

One traditional approach to computer print-outs has been to use a cylindrical rotating drum of type front above the paper, in conjunction with a set of selectively activated hammers behind the paper to strike the paper against a marking ribbon in order to impress the shape of the character on the drum upon the front of the paper. The rotating drums usually have one row for each character with the identical character in each hammer position. The drum is continually rotated at high speed. Selected print hammers are activated to print all like characters in a given line simultaneously. To prevent character smearing and to have different characters aligned, the paper must be stopped and held during the printing operation. Thus, the basic operation of the

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apparatus is to move the paper to a new line, stop, and retain the paper precisely in place while the type drum is allowed to revolve at least enough so that all desired characters have passed under the print hammers."

Riley discloses the following in column 1, lines 6-10:

"This invention relates to a perforated web advancing apparatus and, more particularly, to a synchronized line feed tensioning and gripping apparatus particularly adapted for use with sprocket or tractor feed mechanisms employed in printers and the like."

Kondo discloses the following in the abstract:

"There is described a printing apparatus in which line feed is achieved by rotating a platen with a paper advancing motor and the printing is conducted while the platen is stopped by the paper advancing motor. The printer is further provided with a detent mechanism for stopping the platen at the interval of a determined angle, and a solenoid for deactivating the function of the detent mechanism."

Belson, Riley, or Kondo, taken separately or together, do not disclose or anticipate the invention claimed by Applicant in claim 1, and those claims dependent thereon. The cited patents do not disclose or anticipate a third mechanism, responsive to the displacement of the substrate, for providing a second signal, indicative of the displacement of the substrate by the predetermined distance, for causing the print head to print the next line, wherein the third mechanism comprises an optical sensor that restricts the movement of the print head by a distance substantially equal to the width of one print line.

The Examiner also stated the following in page 34 of the November 18, 2005, Final Rejection.

"Belson, Riley or Kondo do not, however, teach a third mechanism responsive to the displacement. It would be inherent that they ensure that the printhead lines up in the proper place to ensure that the printing is even. It is well within the purview of

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one of ordinary skill in the art to duplicate parts that do the same function (St. Regis Paper Co. v. Bemis Co., 193 USPQ8)."

The Examiner has misconstrued the St. Regis Paper Co. v. Bemis Co. case, no where in the decision does the court advance the proposition that "It is well within the purview of one of ordinary skill in the art to duplicate parts that do the same function."

The court held at page 12 in the St. Regis Paper Co. v. Bemis Co. Inc. decision the following:

"The concept of stepping the plies of a multilayered bag is revealed in Windmoller and Holscher French patent 1,227,176. See Appendix B. While the Windmoller bag was not gusseted and did not call for the stepping of all the plies, the transition from the Windmoller bag to one which was gusseted and had all of the plies stepped was not difficult one for one skilled in the art of manufacturing bags. Moreover, the transition from the Lokey bag to the reissue bags would not have required great inventive flair to a person skilled in the art. The stepping of all of the plies was the work of a skillful mechanic rather than an inventor, and therefore their incorporation in the reissue bags is not entitled to patent projection under the standard of Hotchkiss v. Greenwood."

The Examiner also misinterpreted the doctrine of inherency when he stated "It would be inherent that they ensure that the print head lines up in the proper place to ensure that the printing is even."

The United States Court of Appeals for the Federal Circuit discussed inherency in *Elan Pharmaceuticals Inc. v. Mayo Foundation* 64 USPQ2d 1292, 1296 as follows:

"To be patented an invention must be new. 35 U.S.C. § 101, 102(a), (e). If it is not new, that is, if it was known to others, it is said to be "anticipated." *Hoover Group, Inc. v. Custom Meraicraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack V of novelty (often called 'anticipation') requires that the same invention, including each element and V limitation of the claims, was known or used by others before it was

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invented by the patentee"). Anticipation is a question of fact, as is the question of inherency. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Its proof differs from that for obviousness, 35 U.S.C. § 103, in that prior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference. In re RobertsOn, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 E2d 1560, 1571, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988). The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention. Crown Operations International, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. cir. 2002); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"). The anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). When anticipation is based on inherency of limitations not expressly disclosed in the assertedly anticipating reference, it must be shown that the undisclosed information was known to be present in the subject matter of the reference. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). An inherent limitation is one that is necessarily present; invalidation based on inherency is not established by "probabilities or possibilities." Scaltech, Inc. v. Retec/Tetra, LLC., 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. cir. 1999). "

The cited patents do not inherently disclose applicants claimed third mechanism, namely a third mechanism, responsive to the displacement of the substrate, for providing a second signal, indicative of the displacement of the

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substrate by the predetermined distance, for causing the print head to print the next line, wherein the third mechanism comprises an optical sensor that restricts the movement of the print head by a distance substantially equal to the width of one print line.

Claims 5 & 6 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being clearly anticipated by either Riley (3,917,048) or Kondo (4,971,466).

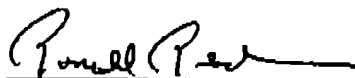
Neither Riley or Kondo taken separately or together disclose or anticipate applicants claimed third mechanism.

Claims 7-11, 21,22 & 29-33 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over either Belson et al (3,644,806) or Riley (3,917,048) or Kondo (4,971,466) as applied to claims 1-3, 12-17 & 23-27 above and further in view of obvious modifications.

Neither Belson, Riley or Kondo taken separately or together disclose or anticipate applicants third mechanism.

In view of the above, claims 1, 3, 5-11, 21, 22 and 29-33, are patentable. If the Examiner has any questions, he is invited to call the undersigned at the telephone number noted below.

Respectfully submitted,



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